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EXAMINER

NICOLAS, FREDERICK C

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/532,073
Filing Date: April 21, 2005
Appellant(s): BRUNA, PASCAL

Raja N. Saliba
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 22, 2009 appealing from the Office action mailed April 4, 2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Co-pending Application No. 10/532,961, having the same inventor and a common assignee as the present application, is currently on appeal to the Board of Patent Appeals and Interferences.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct. The appellant states in section III of the Appeal Brief that the provisional rejection based on non-statutory obviousness-type double patenting is not being addressed on appeal. The provisional non-statutory obviousness-type rejection has not been withdrawn and the claims have not been cancelled. Therefore, the following rejection should be reviewed on appeal:

Claims 1-15 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3,5-11,13-20 of copending Application No. 10/532,961. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-11 of copending Application No. 10/532,961 encompass all the limitations of the above noted claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,564,414	WALKER et al.	10-1996
5,895,159	LIU	12-2001
6,327,017	BARBERI et al.	12-2001
10/532,961	MATTER	4-2005

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims

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are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-15 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3,5-11,13-20 of copending Application No. 10/532,961. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-11 of copending Application No. 10/532,961 encompass all the limitations of the above noted claims.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. 5,564,414 in view of Barberi et al. 6,327,017 and Liou 5,895,159.

Walker et al. disclose an electronic display device (130) including a display member (131), the device being characterized in that the display member is permanent (col. 7, ll. 35-57), the energy required to change the display being created by interaction between two elements (123,135), thereby creating an electric pulse, the pulse being processed by an electronic circuit before being applied to the display member in order to change its display (col. 7, ll. 35-57), the display member is of the liquid crystal display (LCD) type as seen in Figure 2D, a fluid dispenser (10), a reservoir (13), striker pin (123), a spring (128). Walker et al. lack that no energy is required to keep the display unchanged and the display device operates without a battery. Barberi et al. teach the use of a bistable nematic liquid crystal display for use small portable devices (col. 19, ll. 50-55). Liou discloses a current producer (60) that produces an instantaneous current upon a pressing bar (31) striking an internal flint (col. 2, ll. 47-53) in order to avoid the use of an external power source (col. 1, ll. 45-55).

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to utilize the bistable nematic LCD of Barberi et al. in place of the LCD of Walker et al. in order to preserve power. The modified reference would require no energy to keep the display unchanged and only a small electric pulse to change it.

Further, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to have replaced the battery and switch mechanism of Walker et al. and Barberi et al. with the current producer of Liou and its associated components, in order to produce the electric pulse needed to change the LCD display without the need for an external power supply.

(10) Response to Argument

In response to appellant's argument that there is nothing in the prior art to provide a reasonable rationale as to why it would be obvious to combine the references of Walker, Barberi and Liou to produce all of the recited features of independent claim 1, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the reference of Walker et al. teach an inhaler with an LCD display, run from battery power, that changes upon contact of two pieces when the inhaler is actuated (i.e., when the user presses on the

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inhaler to dispense the medicine, electrical components touch and the switch is completed, which allows current to travel to the screen and indicate a change in the display). Barberi et al. teach the use of bistable nematic crystal LCD screens for small portable devices that also run off of an electrical supply such as batteries, because bistable nematic crystals preserve power with LCD displays. Motivation for combining the references was discussed as preserving power. In addition, examiner notes that such a modification would involve mere substitution of one well known method (bistable nematic crystal LCD taught by Barberi et al.) for another (conventional LCD display of Walker et al.) to yield predictable results that do not patentably distinguish an invention over the prior art. Further, it appears as though the device of Walker et al. would perform equally well with any type of well known LCD. As discussed by appellant, bistable nematic crystal displays work by changing the position of the crystals by an electric pulse. So actuating the device of Walker et al. to complete the circuit and send the electrical pulse would suffice for changing the positions of the crystals and thus, the display. Liou then teaches in column 1, lines 45-55 that one way to replace conventional electrical wire power sources (which are well known equivalents to batteries) is to use a striking bar/flint combination to produce an instantaneous electrical current. As discussed in the rejection, motivation for using the striking bar/flint teaching of Liou in the modified Walker et al. device is to avoid the need for an external power supply. Liou is cited merely for teaching that electrical current can be created upon contact of two mechanical pieces without the use of an external battery supply. The fact that Liou uses the current for ignition is irrelevant. One having ordinary skill in the art at the time the

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invention was made would replace the battery and switch mechanism of Walker et al. and Barberi et al. with the current producer of Liou and its associated components, in order to produce the electric pulse needed to change the LCD display without the need for an external power supply. Further, there is no structure in any of the references that would prevent the combination and such a modification appears to be a mere substitution of one well known method (using mechanical pieces to create an electrical current) for another (using batteries/external power supplies to create an electrical current) to yield predictable results that do not patentably distinguish an invention over the prior art. In response to appellant's arguments that both Walker et al. and Barberi et al. teach batteries, examiner contends that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). It is unimportant that these references teach batteries because the combination with Liou discloses a means for replacing an external battery supply which would allow the modified device to perform equally well. The use of a battery supply actually helps leads one to look towards Liou, who teaches a well known means of avoiding use of an external power supply when only small electrical pulses are needed in a device. Since the modified Walker et al./Barberi et al. device requires only a small electrical pulse to change the bistable nematic crystal LCD display, one would look to other well known ways of generating that electrical pulse and/or prolonging the life of the device as long as possible by not wasting power. Just because a reference discloses a feature in a device (such as a

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battery for generating electrical current) does not mean that there is a teaching away from other well known means for solving the same problem (creating an electrical current from mechanical striking) as suggested by appellant. Further, the appellant argues that the reference of Liou is entirely unrelated to powering an LCD display. As discussed above, the reference of Liou is cited merely for its teaching that contacting two mechanical pieces together (such as is done with the original Walker et al. device when actuating the device to complete the circuit and change the display) can create an electrical current without the use of an additional battery. This current would be sufficient for changing the location of the crystals in the modified device of Walker et al. and thus changing the display as required by Walker et al.

In response to appellant's argument that the combination of references does not teach the claimed subject matter in claims 6 and 7 "the interaction between two portions of said device moving relative to each other while the device is being actuated, is transformed by an electromechanical converter into an electric pulse used to change the display" as recited in claim 6. The examiner respectfully disagrees. The reference of Walker et al. specifically disclose changing of the LCD being created by interaction between two elements (123,135), thereby creating an electric pulse and the pulse being processed by an electronic circuit before being applied to the display member in order to change its display (col. 7, ll. 35-57).

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Obviousness-type Double Patenting Rejection

As appellant has provided no arguments with respect to the obviousness-type double patenting rejection over 10/532,961, the Board is requested to affirm this rejection.

For the above reasons, it is believed that the rejections should be sustained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Frederick C. Nicolas/

Primary Examiner, Art Unit 3754

Conferees:

/Kevin P. Shaver/

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